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EXAMINER

ELISCA, PIERRE E

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KATRIN REISINGER

Appeal 2009-014551
Application 09/917,541
Technology Center 3600

Before JOHN A. JEFFERY, HUBERT C. LORIN, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL¹

An oral hearing was held on August 17, 2010.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Katrin Reinsinger (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-27. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.²

THE INVENTION

The invention relates to a mailing machine of the type having a controller, a security module, and a non-removable program memory, such as mail scales with an integrated postage calculator for which approval from a postal authority is required. Specification 1:7-15. The invention provides such a machine “with a ROM module with an initialization program, initialization data being introduced in a secure manner into the mailing machine via an externally accessible interface, so that unauthorized initializing is prevented.” Specification 4:8-12. “Initialization is understood as meaning a routine for the input of initialization data taking place on one occasion at the single point of entry of the destination country before the machine is put into operation.” Specification 5:9-11. “The mailing machine, for example a franking machine, has an unremovable program memory with an initialization program and a postal security module (postal security device or secure accounting device), which is designated as a means

² Our decision will make reference to the Appellant’s Appeal Brief (“App. Br.,” filed Nov. 7, 2005) and Reply Brief (“Reply Br.,” filed May 26, 2009), and the Examiner’s Answer (“Answer,” mailed Mar. 24, 2009).

of checking the authorization of the input of initialization data. The latter takes place, when there is authorization, directly by using the keyboard of the franking machine or indirectly via the PC or laptop or from a data center into the meter or security module. The means of authorization, i.e., the authorization device, is brought into operative connection with the meter via interfaces of the PC or the machine.” Specification 5:16-6:2.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A mailing machine assembly, comprising:
 - a mailing machine including a controller, a security module connected to said controller, and a non-removable program memory operationally connected to said security module and configured to store an initialization program; and
 - a removable authorization device being operationally connected to said mailing machine and configured for being interrogated by said mailing machine; and
 - said security module being programmed to check whether authorization is present and for preventing an initialization of said mailing machine without authorization.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Leon	US 6,424,954 B1	Jul. 23, 2002
Vu	US 6,557,104 B2	Apr. 29, 2003

The following rejection is before us for review:

1. Claims 1-27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Leon and Vu.

ISSUES

Regarding the rejection of claims 1-17, the issue is whether the cited prior art would lead one of ordinary skill in the art to a mailing machine assembly comprising “a removable authorization device being operationally connected to said mailing machine and configured for being interrogated by said mailing machine” (claim 1). The issue with respect to the rejection of claims 18-27 is whether the Examiner has set out a prima facie case of obviousness over the cited prior art and whether the Appellant has shown error in that case.

FINDINGS OF FACT

We rely on the Examiner’s factual findings stated in the Examiner’s Answer (Answer 4-5).

ANALYSIS

“Many of appellant's arguments fail from the outset because, . . . they are not based on limitations appearing in the claims” *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).

The Appellant repeatedly argues that the cited prior art does not teach or lead one to provide “a removable authorization device, authorization from which is necessary for initialization of the mailing machine” (App. Br. 20). However, the subject matter claimed does not require “a removable authorization device, authorization from which is necessary for initialization of the mailing machine” (App. Br. 20).

As to the apparatus claims 1-17, independent claim 1 simply calls for “a removable authorization device being operationally connected to said

mailing machine and configured for being interrogated by said mailing machine.” The mailing machine assembly as claimed in claim 1 does not require initialization of the mailing machine to depend on any function of the removable authorization device. The initialization of the mailing machine assembly as claimed in claim 1 depends on the security module; that is, the “security module being programmed to check whether authorization is present and for preventing an initialization of said mailing machine without authorization” (claim 1). In that regard, Leon discloses a security module (“secure metering device, “SMD”, col. 2, l. 32) that includes an initialization and a check for the presence authorization without which initialization is prevented. *See* Leon, Fig. 5B, reproduced in the Brief at pp. 21-23. Thus, the claimed mailing machine assembly distinguishes from that of Leon not because it fails to disclose “a removable authorization device, authorization from which is necessary for initialization of the mailing machine” (App. Br. 20), but rather because it fails to disclose a removable device that can function to provide authorization. In that regard, the Examiner relied upon Wu as disclosing a removable device that can function to provide authorization. That appears to be the case. As one of many examples, *see* Wu column 1, line 35: “a secret key stored on a token.” Combining Leon’s mailing assembly and Wu’s removable authorization device yields the claimed combination. “[W]hen a patent ‘simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) (quoting *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282 (1976)). The Appellant has not shown that the combination yields

anything more than one would expect from combining Leon's mailing assembly and Wu's removable authorization device.

As to the method claims 18-27, they do not require even a removable authorization device, let alone "a removable authorization device, authorization from which is necessary for initialization of the mailing machine" (App. Br. 20) as the Appellant argues. Accordingly, the Appellant's argument that the cited prior art does not teach or lead one to provide "a removable authorization device, authorization from which is necessary for initialization of the mailing machine" (App. Br. 20) cannot be persuasive as to the patentability of these method claims. The Examiner has set forth a *prima facie* case of obviousness for the subject matter of these claims (*see* Answer 4) and because the sole argument challenging the rejection is not commensurate in scope with what is claimed, the Appellant has not shown error in that *prima facie* case.

The Appellant separately addressed the rejection of claims 4, 24, and 26. But the Appellant simply argues that the subject matter claimed in these claims are not shown in the cited prior art without responding to the Examiner's reasoning in establishing a *prima facie* case of obviousness. "It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art." *In re Baxter Travenol Labs*, 952 F.2d 388, 391 (Fed. Cir. 1991). See also *In re Wiseman*, 596 F.2d 1019, 1022 (CCPA 1979) (arguments must first be presented to the board). A general allegation that the art does not teach any of the claim limitations is no more than merely pointing out the claim limitations. A statement which merely points out what a claim recites

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will not be considered an argument for separate patentability of the claim. 37
C.F.R. § 41.37(c)(1)(vii).

DECISION

The decision of the Examiner to reject claims 1-27 is affirmed.

AFFIRMED

mev

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